

09/826,678
Art Unit 3691
8580

REMARKS

This Amendment is submitted in response to the Office Action mailed on July 25, 2008. Claims 1 - 6, 8, 10, 21 - 25, and 27 are pending, and all stand rejected at present. Claims 28 - 30 are added. No fee is due.

Support for the amendments to the claims can be found at the following locations, and others.

Claim	Location of Support
1	Page 1, line 5; page 3, lines 4, 12, and 13; page 4, lines 16 - 23.
8	Page 4, lines 16 - 23.
21	Previous claim 1.
28	Page 2, line 28; page 3, line 17.
29	Page 3, lines 2, 3.
30	Page 2, line 28; page 3, line 17; page 6, lines 25, 26; page 7, line 2.

RESPONSE TO REJECTION OF CLAIMS 1 - 3, 8, 10, AND 27

These claims were rejected as obvious, based on Dickson and Hayashi.

Claim 1

Claim 1 recites, in part:

locating the vehicle adjacent an ATM;

09/826,678
Art Unit 3691
8580

transferring one or more computer programs from the ATM to an in-car data entry facility maintained within the vehicle, which programs generate a user interface in the entry facility.

The following discussion will show that

- 1) the combined references do not show these recitations,
- 2) the references are contradictory,
- 3) the combination of references is inoperative,
- 4) no expectation of success has been shown, indicating that the combined references actually do anything, and
- 5) no valid teaching has been given for combining the references.

Point 1

Claim 1 states that the vehicle is "adjacent" an "ATM." However, in Hayashi, the vehicle can be located anywhere within radio range of the "center." At no location does Hayashi state that the vehicle is "adjacent" the "center."

Further, that would be contradictory to Hayashi, who clearly intends to transmit programs to hundreds, if not thousands, of vehicles. There is no room for such vehicles at the "center,"

09/826,678
Art Unit 3691
8580

nor is there any reason for them to be "adjacent" the "center."

In essence, Hayashi shows a radio station, and his vehicles receive the transmitted programs from the station. The transmissions literally are "programs" on radio.

Point 2

Claim 1 states that the "ATM" transfers "programs" to a device within the vehicle. The "center" of Hayashi does not qualify as the claimed "ATM" performing this transfer.

-- Hayashi's "center" performs no "transactions," as claimed.

-- The claimed ATMs dispense cash.

Hayashi's "center" cannot do that, at least because (1) he does not discuss that and (2) the vehicles are not near his "center" (so they cannot receive anything which is dispensed).

If it is argued that Hayashi's downloading of the programs is a "transaction," then Applicant points out that double-counting is occurring. Double-counting is present because a **single** event in Hayashi is being used to show **two claim elements**.

That is, the claim recites (1) steps involved in a financial transaction with the ATM and (2) downloading of a program. Hayashi's downloading of a program cannot be used to show both.

Point 3

Claim 1 states that the "programs generate a user interface." Hayashi does not state what his programs do.

- They could be music programs.
- They could control the engine in a car.
- They could be games.
- They could be navigation programs.
- They could diagnose engine problems.

Thus, this claim recitation is not found, even if the references are combined.

Interim Conclusion

The references are contradictory as to where the vehicle is located. Contradictory references cannot be combined. Restated: if you select one of the teachings (Hayashi), you do not attain the claim. No explanation has been given as to why one teaching should be selected over the other.

The two claim recitations of Points 2 and 3, above, are not found in the references, even if combined. That is, in the references,

- no "ATM" transfers the "programs," and
- no transferred "program" generates a "user interface."

09/826,678
Art Unit 3691
8580

MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

Point 4

Amended claim 1 states that the "instructions" are entered into the "user interface." That "interface" was generated by the program which was transferred.

Again, Hayashi is silent as to the type of program he transfers.

Thus, nothing in the combined references shows (1) "instructions" (2) which are entered into a "user interface" (3) which interface is generated by a "program" (4) which is transferred from an ATM (5) which ATM is "adjacent" the vehicle.

At least five claim recitations are missing from the combined references.

Point 5

Claim 1 states that the instructions, which were entered into the "interface" created by the transferred "program," are sent **back to** the "ATM" (which transferred the "program").

That set of multiple elements and relationships is not shown in the references, even if combined.

09/826,678
Art Unit 3691
8580

Point 6

Amended claim 1 recites (1) transfer of "information" to the "user interface" and (2) transfer of a user's response to the "information" **back to** the ATM. (For example, the ATM may transfer advertising information to the vehicle, describing services available. See Specification, page 3, line 21 et seq.)

That is not found in Hayashi.

Nor is that found in Dickson. The Office Action cites Hayashi as showing the transfer of the "program" to the vehicle, which "program" generates the "user interface." Even if that be so, there is no "information" in Dickson which is transferred from an ATM to Hayashi's program, and presented to the user.

Point 7

No expectation of success has been shown, or the modification of references renders Dickson inoperative, or both.

re: INOPERATIVE

Applicant points out that, in general, a **single program** runs on a microprocessor at any given time. That is, a program is a sequence of instructions, which are fed to the processor in sequence.

It may be possible to design a multi-processor system, which runs multiple programs at once, but that has not been shown in

09/826,678
Art Unit 3691
8580

the references.

Thus, if the program of Hayashi is inserted into the in-car device in Dickson, then Hayashi's program **replaces** any program present in the device. Dickson is rendered inoperative.

MPEP § 2143.01 states:

THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED
PURPOSE

If proposed modification would render the
prior art invention being modified
unsatisfactory for its intended purpose, then
there is **no suggestion or motivation** to make
the proposed modification.

re: EXPECTATION OF SUCCESS

Hayashi does not explain what his programs do. Thus, the Office Action, in essence, is suggesting that a randomly selected computer program, whose function is unknown, is to be inserted into Dickson's in-vehicle device.

That shows no expectation of success in attaining the claimed invention, nor that anything which actually works is obtained. MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of
obviousness, three basic criteria must be
met.

. . . .

Second, there must be a reasonable expectation of success.

. . . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Point 8

The rationale for combining the references is that the combination is "within the capabilities of one of ordinary skill in the art." (Office Action, page 5, top.)

Applicant points out that this rationale is specifically prohibited by the MPEP. MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE COMBINED** OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

. . . .

FACT THAT THE CLAIMED INVENTION IS **WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL** IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed

invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

Point 9

Claim 1 states that the transfer of programs occurs **after** positioning the vehicle adjacent the ATM. Applicant points out that neither Dickson nor Hayashi shows an ATM.

Applicant further points out that nothing has been shown in the references which suggests this claim recitation.

Point 10

Amended claim 1 states that the in-vehicle terminal, by itself, has some capability of interacting with the ATM. The transferred programs provide additional capability.

. Neither reference shows that.

Point 11

The claim recites an ATM. Neither reference shows that.

Claims 2, 3, 10, and 27

The discussion above applies to these dependent claims.

Claim 8

09/826,678
Art Unit 3691
8580

The discussion above applies to the parts of claim 8 which are similar to claim 1.

Comment on Claim 27

Claim 27 states that a "a second user interface, different from said interface" is created at a different ATM.

That has not been shown in the references. Further, that is contrary to Hayashi.

Hayashi has been cited to show the claimed program which generates the "interface." As explained above, Hayashi does not explain what his program does.

Thus, there is no reason to believe that he has a different program, which generates "a second user interface, different from said interface," let alone doing that at the claimed second location.

Claim 27 is not found in the references, even if combined.

Added Dependent Claims 28 - 30

Claim 28

Claim 28 states that certain material is **not** transmitted over a wireless network. Hayashi states that his transmissions are by "radiocommunication or the like." (Column 1, line 24.)

That would seem to refer to a cell phone network, and a cell modem, which uses a wireless network.

09/826,678
Art Unit 3691
8580

Hayashi is thus **directly contrary** to claim 28.

Claim 29

Claim 29 states that the vehicle is at a "known location." That is contrary to Hayashi. Hayashi does not know the location of the vehicles.

A possible exception is that, since Hayashi may receive an acknowledgement from the vehicles, then Hayashi is within the maximum transmission range of the vehicle. However, that does not actually indicate the vehicle's location. For example, if the transmission range is 5 miles, then it is only known that the vehicle is somewhere in a circle of radius of 5 miles, or within an area of $(\pi \times 5 \times 5)$ square miles, or over 75 square miles.

Knowing a location within 75 square miles does not provide a "known location" as claimed.

Claim 30

The discussion of claim 29 applies here.

RESPONSE TO REJECTION OF CLAIMS 21, 23, AND 24

Claim 21

Point 1

No valid teaching has been given for combining the references.

09/826,678
Art Unit 3691
8580

The rationale given on page 7 of the Office Action merely describes features of the references, but once combined. Applicant points out that this is backward reasoning, as will now be elaborated.

POINT 1A

Applicant points to MPEP § 706.02(j). This MPEP section states that

- 1) a **REASON** for modifying the references must be given, and
- 2) the **MODIFICATION** must produce the claimed invention.

To repeat: the **REASON** leads to the **MODIFICATION** which produces the claimed invention.

To repeat again: the **REASON** comes first.

The Office Action is not following this approach.

Instead, the Office Action justifies the combination on the grounds that **something desirable is attained**.

The Office Action does not follow the MPEP section, because the Office Action applies a post hoc analysis.

That is, the Office Action relies on qualities of the references, but **after combining them**. That is, the qualities do not exist in the **separate** references, but in the combination.

But the reason given for the combination is **those qualities**

09/826,678
Art Unit 3691
8580

themselves.

POINT 1B

From another perspective, the MPEP's sequence is this:

TEACHING -->> MODIFICATION -->> CLAIMED INVENTION

That is, the teaching (or reason) leads to the modification/combination of references, which produces the claimed invention.

In contrast, the Office Action's sequence is this:

MODIFICATION -->> DESIRED QUALITIES -- >>

TEACHING -->> MODIFICATION -->> CLAIMED INVENTION

That is, the modification/combination of the references leads to the desired qualities. Those desired qualities are treated as the teaching for combining/modifying the references in the first place.

The Office Action's approach is a post hoc analysis. It does not start with a teaching, as the MPEP requires.

POINT 1C

The Office Action's approach employs circular logic. That

09/826,678
Art Unit 3691
8580

is, the modified references are taken as showing desirable qualities. Those desirable qualities are taken as a teaching for making the modification.

That is circular logic.

Point 2

The Office Action asserts that the claimed invention is merely a combination of old elements, which function as they do in the prior art. (Office Action, page 7, first full paragraph.)

In response, Applicant points out that amended claim 21 recites transfer of computer programs. Neither Dickson not deVries shows that.

RESPONSE TO REJECTION OF CLAIMS 22 AND 25

Claim 22

Content of claim 22 was incorporated into claim 21, and is discussed under the latter claim.

Claim 25

The discussion of claim 1 applies to claim 25.

RESPONSE TO REJECTION OF CLAIMS 4 - 6

These claims are seen as allowable, based on their parent claim 1.

09/826,678
Art Unit 3691
8580

COMMENT ON OFFICE ACTION

The Office Action, page 4, last paragraph, states:

Examiner further notes that a program which, when run, determines what is displayed is equivalent to a program generating a display.

Applicant submits that this assertion suffers from several problems.

Problem 1

MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

Applicant points out that the Office Action's assertion fails to comply with this MPEP section.

Problem 2

The Office Action's assertion is not relevant. The claims recite a program which generates a **user interface**. The claims do not state that the program determines what is displayed, and the mere display of something does not generate a user interface.

09/826,678
Art Unit 3691
8580

Problem 3

The Office Action's assertion is incorrect on its face. The assertion fails to distinguish between (1) a program which causes something to be displayed within a larger image on a screen and (2) the program which generates the larger image.

For example, in the Microsoft program "Windows," numerous individual windows can be open at once on a screen. The content of each individual window is determined by a respective program. But Windows controls the overall display, and the overall appearance of the individual windows.

The programs merely control **part of the display** within the individual windows. That clearly shows that the Office Action's assertion is incorrect. That is, it is incorrect to say that

. . . a program which determines what is displayed is equivalent to a program generating a display.

The simple reason is that "what is displayed" is merely **part of** a larger display.

Problem 4

The assertion is a tautology. A tautology is a statement that repeats itself, but in different words.

The statement in question should be reduced to its actual

09/826,678
Art Unit 3691
8580

content:

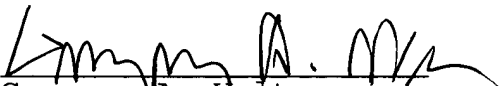
. . . a program which determines what is
displayed does this: determine what is
displayed.

CONCLUSION

Applicant requests that the rejections to the claims be
reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful
consideration given to this case.

Respectfully submitted,


Gregory A. Weite
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 4
Dayton, OH 45479

August 21, 2008
(937) 445 - 4956